



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/655,231	09/05/2000	Hajime Yano	450100-02694	7766

20999 7590 06/07/2004

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

VENT, JAMIE J

ART UNIT	PAPER NUMBER
----------	--------------

2613

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/655,231

Applicant(s)

YANO ET AL.

Examiner

Jamie Vent

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-16 are rejected under 35 U.S.C. 102(e) as being unpatentable by Browne et al (US 6,642,939).

[claims 1, 8, & 9]

In regard to Claims 1, 8, and 9, Browne et al discloses a recording/reproduction apparatus and method comprising:

- A information recording means for recording proper information to be recorded including information on the time and date of recording on a recording medium from the recording starting point of said recording medium in the order of time and date of recording (Figure 1 shows the recording/reproducing apparatus while Figure 6 shows the programs recorded with such information as title, time, date, length, etc.);
- Recording capacity determining means for judging if said recording medium has a remaining recording capacity sufficient for recording said information to be recorded (Figure 6 shows in the upper right hand corner a "Free Program Memory

4.75 HRS” thereby determining the remaining recording capacity and judge which remains with what programs are currently recorded or deleted);

- An oldest information detecting means for detecting one or more than one pieces of information having the oldest time and date of recording out of the plurality of pieces of information recorded on said recording medium (Figure 3 element 301 shows a Program erasure which allows for the oldest programs to be erased depending on date, viewed or selected); and
- Recording control means for controlling the operation of recording information not recorded on said recording medium in the recording area of said recording medium storing said one or more than one pieces of information having the oldest time and date of recording as detected by said oldest information detecting means if the information not recorded on said recording medium is supplied and said recording capacity determining means judges that said recording medium does not have said remaining recording capacity (Figure 3 shows the program erasure selection of oldest programs to be erased as well as the comparison of allocation of space as seen in 305a in determining if the oldest program will be deleted and further described on Pages 18-21).

[claims 2 & 14]

In regard to Claims 2 and 14, Browne et al discloses a recording/reproduction apparatus and method comprising:

- An erasure prohibiting means for specifying the predetermined one or more than one pieces of information recorded by said information recording means on said

recording medium for prohibition of erasure (Figure 6 allows the user to lock a program which allows for the show not to be deleted);

- Recording control means being adapted to so control the information recording means as to cause it to record the information not recorded on the recording medium in the recording area on the recording medium storing one or more than one pieces of recorded information having the oldest time and date of recording except the predetermined one or more than one pieces of recorded information specified by the erasure prohibiting means (Figure 1 shows an optional storage 104b which can be adapted to record items not recorded on the storage medium 104a as further described on Page 11).

[claims 3, 10, 11, & 15]

In regard to Claim 3, 10, 11, and 15, Browne et al discloses a recording/reproducing apparatus and method comprising:

- A time and date of recording changing means for changing the information on the time and date of recording accompanying the predetermined one or more than one pieces of information recorded by said information recording means on said recording medium (Figures 4a-4c allow for changing of program information such as: date (4a-4b) and time (4c)).

[claims 4, 5, 6, & 7]

In regard to Claims 4, 5, 6, and 7, Browne et al discloses a recording and reproducing apparatus and method comprising:

- An additional information recording means for recording information on an additional recording medium (Figure 1 optional storage 104b);
- Specification canceling means for canceling the specification of the predetermined one or more than one pieces of recorded information for prohibition of erasure as specified by the erasure prohibiting means (Figure 5e shows the canceling and overriding of one program when a conflict occurs);
- Record control means being adapted as to control the information recording means when a piece of information not recorded on the recording medium is supplied and it is determined by the recording capacity determining means that the first recording medium does not have a remaining recording capacity sufficient for recording and information to be recorded to cause the information recording means to reproduce the one or more than one pieces of information stored on the recording medium with the oldest time and date of recording as detected by the oldest information detecting means out of the recording area of the recording medium to be used for recording the information not recorded on the recording medium and record the reproduced information on the recording medium (Figure 6 shows the recording control of programs. It is shown if free program memory as well as a method for sending the program to the optional storage medium);

[claim 12]

In regard to Claim 12, Browne et al discloses a recording/reproduction apparatus and method comprising a display section for displaying the one or more than one pieces of recorded

information with the oldest time and date of recording as detected by the oldest information detecting means except with one or more than one pieces of recorded information specified by the erasure prohibiting means (Figure 3 element 301 shows a Program erasure which allows for the oldest programs to be erased depending on date, viewed or selected).

[claim 13]

In regard to Claim 13, Browne et al discloses a recording/reproducing apparatus and method comprising determining and detecting steps as previously disclosed in Claim 1, with the additional limitation of recording updating step of recording information not recorded on the recording medium in the recording area of the recording medium storing said one or more than one pieces of information having the oldest time and date of recording as detected in the oldest information detecting step if the information not recorded on the first recording medium is supplied and it is judged in the recording capacity determining step that the recording medium does not have the remaining recording capacity (Figure 6 shows the various recordings while #1 is shown not to be recorded but is used for determination of the free program memory and further explained on Pages 25-26).

[claim 16]

In regard to Claim 16, Browne et al discloses a recording/reproducing method wherein a pieces of information not recorded on the recording medium is supplied and it is determined in the recording capacity determining step that the recording medium does not have a remaining recording capacity sufficient for recording the information to be recorded, the one or more than one pieces of information stored on the recording medium with the oldest time and date of recording as detected in the oldest information detecting step are reproduced out of the recording

Art Unit: 2613

area of the first recording medium to be used for recording the information is recorded on the recording medium in the recording updating step (Figure 3 shows the storage allocation 305a if that fills up then programs determined by the user will be deleted whether it be the oldest, oldest viewed, or only selected programs and further described on Pages 19-21).

Conclusion

The prior art made of record and not relied upon are considered pertinent to applicant's disclosure. The following is considered of significant interest to the application:

- Otana (6,636,688);
- Sumita et al (6,581,207);
- Vallone et al (6,642,939);
- Wood et al (6,324,338);
- Sawanda (6,085,262); and
- Stebbings et al (5,325,238).

Contact Fax Information

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

Or faxed to:

703.208.6306 (for formal communication intended for entry)
703.308.5359 (for informal or draft communications, please label "PROPOSED"
or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Contact Information

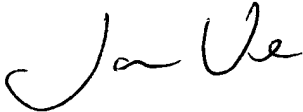
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie J. Vent whose telephone number is (703) 305-0378.

Art Unit: 2613


If any attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley, can be reached at (703) 305-4856.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Miss Jamie Vent
05/25/2004



VINCENT BOCCIO
PRIMARY EXAMINER